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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,056	11/10/2000	Lisa A. Demko	60709-00013	4136

7590 06/30/2003

John S. Beulick, Esq.
Armstrong Teasdale, LLP.
Suite 2600
One Metropolitan Sq.
St. Louis, MO 63102

EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,056

Applicant(s)

DEMKO ET AL.

Examiner

John M Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 28-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3621

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-27 are drawn to multi-leveled review of business deals is classified in class 705 subclass 1.
 - II. Claims 28-55 are drawn to managing business operations, classified in class 705 subclass 10.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions I, and II are different in function and operation.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The Applicant states that event the claims of Group I and the claims of Group II are encompassed by a single class, and it is not evident how the searching of a single class could present an unreasonable burden on the Examiner.

The Examiner responds that the claims of Group I and Group II are directed towards different subclasses within the 705 class, specifically the claims of Group I are grouped in subclass 1 of class 705, and are drawn towards to multi-leveled review of business deals, whereas the claims of Group II are grouped in subclass 10 drawn to managing business operations.

Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via paper 7 filed on April 23, 2003 the applicant has elected the examination of invention I directed towards claims 1-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 28-55 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-27 have been examined

Claim Rejections - 35 USC §101

Art Unit: 3621

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1 only recites an abstract idea. The recited steps of merely creating and analyzing and forwarding a draft of a deal does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to inform an individual about the status of their privacy rights.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a review of a draft deal which is eventually accepted or declined (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Claims 2-14 are rejected under 35 U.S.C. as being dependant on claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruffin, (US Patent No 6,219,654) in view of Conklin et al. (US Patent No 6,141,653).

As per claim 1,

Ruffin ('654) discloses a method for increasing efficiency of multi-level review of proposed business deals using an organizational management tool, the tool configured with a

Art Unit: 3621

database of deals and a plurality of authorized reviewers for the deals, said method comprising the steps of:

creating a draft deal for submission to a coordinator; (Column 6, lines 28-32)

analyzing the deal and selecting a list of reviewers for the deal (Column 2, lines 6-18; also figure 3);

Ruffin ('654) does not specifically disclose forwarding the deal to a next review level and analyzing the deal, Conklin et al. ('653) discloses forwarding the deal to a next review level (Column 25, lines 12-20) and analyzing the deal (Column 25, lines 6-18) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Ruffin method with the Conklin et al. method in order to reject deals that are obviously nonprofitable.

Conklin et al. discloses the claimed invention except for repeating steps c and d until a maximum approver accepts or declines the deal, It would have been obvious to one having ordinary skill in the art at the time the invention was made to repeat steps c and d until a maximum approver accepts or declines the deal, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As per claim 2,

Ruffin ('654) discloses a method according to Claim 1,

wherein said step of creating a draft deal for submission to a coordinator further comprises the step of attaching at least one of deal information, a pitch related to the deal, supporting materials for the deal and a cover memo for the deal. (Column 18, lines 9-20)

As per claim 3,

Ruffin ('654) discloses a method according to Claim 1,

Official Notice is taken that "selecting a maximum reviewer for the deal" is common and well known in prior art in reference to multi level reviews. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a maximum reviewer for the deal because this would allow unresolved issues regarding the deal to be easily arbitrated.

As per claim 4,

Ruffin ('654) discloses a method according to Claim 1,

wherein said step of creating a draft deal for submission to a coordinator further comprises the step of notifying a coordinator of the deal.(Figure 10)

As per claim 5,

Ruffin ('654) discloses a method according to Claim 1,

Official Notice is taken that "reviewing submitted documents for completeness" is common and well known in prior art in reference to multi level reviews. It would have been obvious to one having ordinary skill in the art at the time the invention was made to review submitted documents for completeness because this would promote customer satisfaction with the process.

Art Unit: 3621

As per claim 6,
Ruffin ('654) discloses a method according to Claim 1,
wherein said step of analyzing the deal further comprises the step of making
recommendations regarding the deal.(Figure 10)

As per claim 7,
Ruffin ('654) discloses a method according to Claim 1,
Ruffin ('654) does not specifically disclose adding comments regarding the deal,
Conklin et al. ('653) discloses adding comments regarding the deal (Figure 15B). It would have
been obvious to one having ordinary skill in the art at the time the invention was made to
combine the Ruffin method with the Conklin et al. method in order to preserve IP associated
with the project.

As per claim 8
Ruffin ('654) discloses a method according to Claim 1,
Official Notice is taken that "appending a cover memo regarding the deal" is common
and well known in prior art in reference to multi level reviews. It would have been obvious to
one having ordinary skill in the art at the time the invention was made to append a cover memo
regarding the deal because would improve the security of the document by preventing
unintended reading of the front page.

As per claim 9,
Ruffin ('654) discloses a method according to Claim 1,
Official Notice is taken that "sending a notification including links to deals for review to
a reviewer" is common and well known in prior art in reference to multi level reviews. It would
have been obvious to one having ordinary skill in the art at the time the invention was made to
send a notification including links to deals for review to a reviewer because utilizing a web based
method of distributing data is inexpensive and efficient.

As per claim 10,
Ruffin ('654) discloses a method according to Claim 9,
Official Notice is taken that "sending a delinquency notice to a reviewer" is common and
well known in prior art in reference to multi level reviews. It would have been obvious to one
having ordinary skill in the art at the time the invention was made to send a delinquency notice to
a reviewer because this would allow the give the reviewers an incentive to work efficiently.

As per claim 11,
Ruffin ('654) discloses a method according to Claim 1,
Official Notice is taken that "notifying a submitter of the draft deal each time a reviewer
has completed a review" is common and well known in prior art in reference to multi level
reviews. It would have been obvious to one having ordinary skill in the art at the time the
invention was made to notify a submitter of the draft deal each time a reviewer has completed a
review because this would allow submitter to gauge the progress of the review.

Art Unit: 3621

As per claim 12,
Ruffin ('654) discloses a method according to Claim 1,
further comprising the step of notifying a submitter of the draft deal of a resolution
regarding the deal (Figure 10).

As per claim 13,
Ruffin ('654) discloses a method according to Claim 1,
further comprising the step of storing a review status of a draft deal.(Column 8, lines 48-
60; also Figure 10)

As per claim 14,
Ruffin ('654) discloses a method according to Claim 1,
Official Notice is taken that "forwarding to authorized users based on stored role information
which limit user capabilities" is common and well known in prior art in reference to multi level
reviews. It would have been obvious to one having ordinary skill in the art at the time the
invention was made to forward to authorized users based on stored role information which limit
user capabilities because this would improve the security of the system.

As per claim 15,
Ruffin ('654) discloses a system for facilitating multi-level review of proposed business
deals, said system comprising:
at least one computer; (figure 10)
a network connecting said at least one computer to said server;(Column 8, lines 40-47)
a user interface including web pages configured to allow users and reviewers to input and
receive information relating to the proposed deals.(figure 4)

Ruffin ('654) does not specifically disclose a server configured to store a database of
proposed business deals and further configured to upload and store submitted deal drafts, upload
and store at least one analysis of the deal drafts, upload a list of reviewers for the deal drafts,
forward the deal draft to a next named reviewer from the list of reviewers and to upload and store
an approval or a declining of the draft deal; Conklin et al. ('653) discloses a server configured to
store a database of proposed business deals and further configured to upload and store submitted
deal drafts, upload and store at least one analysis of the deal drafts, upload a list of reviewers for
the deal drafts, forward the deal draft to a next named reviewer from the list of reviewers and to
upload and store an approval or a declining of the draft deal; (Column 25, lines 12-20 and
column 25, lines 6-18) It would have been obvious to one having ordinary skill in the art at the
time the invention was made to combine the Ruffin method with the Conklin et al. method in
order to reject deals that are obviously non-profitable.

As per claim 16,
Ruffin ('654) discloses a system according to Claim 15
wherein said server is further configured to upload and store at least one of a pitch related to the
draft deal, supporting materials for the draft deal and a cover memo for the draft deal.(Column
18, lines 9-20)

Art Unit: 3621

As per claim 17,

Ruffin ('654) discloses a system according to Claim 15,

Official Notice is taken that "selecting a maximum reviewer for the deal" is common and well known in prior art in reference to multi level reviews. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a maximum reviewer for the deal because this would allow unresolved issues regarding the deal to be easily arbitrated.

As per claim 18,

Ruffin ('654) discloses a system according to Claim 15

wherein said server is further configured to notify a coordinator that a draft deal has been submitted.(Figure 10)

As per claim 19,

Ruffin ('654) discloses a system according to Claim 15,

wherein said server is further configured to upload and store recommendations regarding the draft deal. (Figure 10)

As per claim 20,

Ruffin ('654) discloses system according to Claim 15,

Ruffin ('654) does not specifically disclose server is further configured to upload and store comments regarding the draft deal, Conklin et al. ('653) discloses server is further configured to upload and store comments regarding the draft deal (Figure 15B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Ruffin method with the Conklin et al. method in order to preserve intellectual property associated with the project.

As per claim 21

Ruffin ('654) discloses a system according to Claim 15,

Official Notice is taken that "an appended a cover memo regarding the deal" is common and well known in prior art in reference to multi level reviews. It would have been obvious to one having ordinary skill in the art at the time the invention was made to upload and store an appended cover memo regarding the deal because would improve the security of the document by preventing unintended reading of the front page.

As per claim 22,

Ruffin ('654) discloses a system according to Claim 15,

Official Notice is taken that "notify a reviewer of deal drafts to be reviewed and further configured to include links to those deal drafts for review" is common and well known in prior art in reference to multi level reviews. It would have been obvious to one having ordinary skill in the art at the time the invention was made to send a notification including links to deals for review to a reviewer because utilizing a web based method of distributing data is inexpensive and efficient.

As per claim 23,

Art Unit: 3621

Ruffin ('654) discloses a system according to Claim 15,

Official Notice is taken that "notify a submitter of the draft deal each time a reviewer has uploaded a review" is common and well known in prior art in reference to multi level reviews. It would have been obvious to one having ordinary skill in the art at the time the invention was made to notify a submitter of the draft deal each time a reviewer has completed a review because this would allow submitter to gauge the progress of the review.

As per claim 24,

Ruffin ('654) discloses a system according to Claim 15

wherein said server is further configured to notify a submitter of the draft deal when a resolution regarding the draft deal has been uploaded.(Figure 10)

As per claim 25,

Ruffin ('654) discloses a system according to Claim 15 wherein said server is further configured to store a review status of a draft deal. (Column 8, lines 48-60; also Figure 10)

As per claim 26

Ruffin ('654) discloses a method according to Claim 15

Official Notice is taken that "send a delinquency notice to a reviewer" is common and well known in prior art in reference to multi level reviews. It would have been obvious to one having ordinary skill in the art at the time the invention was made to send a delinquency notice to a reviewer because this would allow the give the reviewers an incentive to work efficiently.

As per claim 27,

Ruffin ('654) discloses a system according to Claim 15,

Official Notice is taken that "limit user capabilities based on stored role information" is common and well known in prior art in reference to multi level reviews. It would have been obvious to one having ordinary skill in the art at the time the invention was made to limit user capabilities based on stored role information because this would improve the security of the system.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

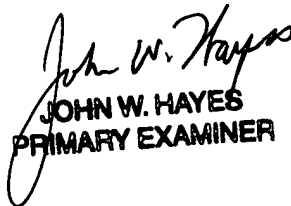
Art Unit: 3621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

June 24, 2003


JOHN W. HAYES
PRIMARY EXAMINER